

### CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

### ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

### REMARKS

Claims 1, 5 and 6 have been amended. Claims 9-11 have been added. Claims 1-11 are now pending. It is believed that no new matter has been added.

#### ***35 U.S.C. § 112, second paragraph rejections***

It is believed that the amendments to the claims overcome all but three of the rejections made by examiner.

With regard to the other two rejections, the examiner is reminded about MPEP 2173.02 - clarity and precision which is directed toward 112, second paragraph rejection which states:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, ***not whether more suitable language or modes of expression are available***. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a ***reasonable*** degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. ***Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.***

With this in mind, the applicants hold that use of the term "finely dispersed" and "preparation" are appropriate. (Also note that page 4, line 19-23 states that finely dispersed cosmetic or dermatological preparations are also known in the art as hydrodispersions. Thus, one of ordinary skill in the art would know the meaning of the term as used or the term hydrodispersion).

It is unclear what is the basis for the rejection about the physical characteristics of the boron

nitride used in the claims. (If the boron nitride is inherently amphiphilic, it does not need to be treated; if it is not, it can be treated in the manner suggested in the specification. The claim merely states that it is irrelevant how the boron nitride was obtained so long as it has the claimed characteristics).

### **35 U.S.C. 103(a) rejection**

**Claims 1-8** have been rejected by the examiner as being obvious over Gers-Barlag et al. (U.S. Patent #5,725,844) in view of Introini (*Cosmet. Toiletries*, 1997, vol. 18, no. 3 - hereafter referred to as Introini #3)

The Gers-Barlag et al. reference is directed toward a **water resistant** cosmetic or dermatological light protection formulation. MPEP 2143.01 states that in order to provide a suggestion or motivation to modify the reference used, the proposed modification cannot render the prior art unsatisfactory for its intended purpose and cannot change the principle of operation of a reference.

Even if one were to assume that the boron nitrides used in Introini #3 are identical to those used by the applicants, one of ordinary skill in the art would not use a substance which has hydrophilic ("water-loving") properties to a formulation designed to be water resistant (i.e. Introini et al. represents a teaching away).

With regard to the examiner's interpretation of what the Introini #3 reference teaches, the examiner appears to be rely on inherency to establish an equivalency between the types of boron nitrides used by the applicants and by Introini #3. However, inherency is an anticipation (102) argument not an obviousness (103) argument.<sup>1</sup> The standard for establishing equivalency for obviousness is "Implicit Disclosure" (see MPEP 2144.01): "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference **but also inferences which one skilled in the art would reasonably be expected to draw therefrom.**" *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) - bold and italics added by writer.

From the facts that can be drawn from the Introini #3 references, one skilled in the art would only know that boron nitride was used and that the supplier was Advanced Ceramics. One skilled in the art would not "draw therefrom" that the boron nitride used was amphiphilic or had the particle sizes claimed by the applicants.

<sup>1</sup> If for example, the applicants had claimed strictly an amphiphilic boron nitride compound, perhaps Introini et al. could've been used as part of a 102 rejection by stating that Introini et al. inherently teaches the claimed characteristic of the applicants boron nitride compound. This would be backed up by a 103 rejection in case the characteristics are different. However, even in this situation it is still incumbent on the examiner to explain why one of ordinary skill in the art would find the modification of the characteristic to be an obvious variation.

*Claims 1-8* have been rejected by the examiner as being obvious over Gers-Barlag et al. (U.S. Patent #5,725,844) in view of Introini (*Cosmet. Toiletries*, 1997, vol. 18, no. 2 - hereafter referred to as Introini #2)

The applicants believe that the Introini #2 reference has similar deficiencies as the Introini #3 reference. The argument above would also apply for this rejection.

***Closing***

Applicants believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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**CERTIFICATE OF MAILING**

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents, Washington, D.C. 20231, on the date indicated below:

Date: **5 December 2001**

By Howard C. Lee  
Howard C. Lee

## CLEAN COPY OF THE CLAIMS SHOWING AMENDMENTS

1. Cosmetic or dermatological preparations, which are finely dispersed [systems of the] oil-in-water or water-in-oil [type] systems, comprising

[1.] (i) an oil phase,

[2.] (ii) an aqueous phase ,

[3.] (iii) boron nitride which has both hydrophilic and lipophilic properties[, i.e. **has amphiphilic character,**] and is dispersible both in water and in oil, and

[4.] (iv) at most 0.5% by weight of one or more emulsifiers.

2. Preparations according to Claim 1, characterized in that they are emulsifier-free.

3. Preparations according to Claim 1, characterized in that further cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients are present.

4. Preparations according to Claim 1, characterized in that the content of boron nitride is between 0.1% by weight and 30% by weight, based on the total weight of the preparations.

5. Preparations according to Claim 1, characterized in that the average particle diameter of the boron nitride particles used is less than 20  $\mu\text{m}$ [, **particularly advantageously less than 15  $\mu\text{m}$** ].

6. Preparations according to Claim 1, characterized in that, in addition to boron nitride, further pigments are present, [in particular modified polysaccharides and/or microfine polymer particles and/or micronized, inorganic pigments which are chosen from the group of amphiphilic metal oxides, in particular from the group consisting of titanium dioxide, zinc oxide, iron oxides or iron mixed oxides, silicon dioxide or silicates, where the pigments can be present either individually or as a mixture.] which are selected from the group consisting of modified polysaccharides; microfine polymer particles; micronized, inorganic pigments; and mixtures thereof.

7. Preparations according to Claim 1, comprising one or more additives or active ingredients selected from the group consisting of antioxidants and/or UV protectants.
8. Preparations according to Claim 1, comprising one or more additives or active ingredients selected from the group consisting of astringents and/or antimicrobially effective substances and/or substances effective against acne.
9. Preparations according to Claim 5, characterized in that the average particle diameter of the boron nitride particles used is less than 15  $\mu\text{m}$ .
10. Preparations according to Claim 6, characterized in that the micronized, inorganic pigments are amphiphilic metal oxides.
11. Preparations according to Claim 10, characterized in that the amphiphilic metal oxides are selected from the group consisting of titanium dioxide, zinc oxide, iron oxides or mixed iron oxides, silicon dioxide, silicates and mixtures thereof.